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ON 18 November 2004

[Signature]
ATTORNEY FOR APPLICANT

18 November 2004
DATE

Attorney Docket No. P50383D2

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Burch et al.	18 November 2004
Serial No.:	10/719,211	Previous Art Unit.: 1614
Filed:	21 November 2003	Previous Examiner: D. Jagoe
For:	PHARMACEUTICAL FORMULATION	

Mail Stop Petition

Commissioner of Patents

P.O. Box 1450

Alexandria, VA 22313-1450

REQUEST FOR RECONSIDERATION

Dear Sir:

This letter is in response to the Decision on Petition, mailed 19 October 2004 in the above noted application. This request for reconsideration is filed within two months of the mailing date.

The Decision on Petition (copy enclosed) indicates that should Applicants state which set of drawings the office should use as part of the official application the petition would be granted as Applicants did enclose a copy of WO 97/09042.

Applicants wish to clarify the record regarding the drawings and copies of WO 97/09042 in this instance.

The original PCT application, PCT/US96/14554, published as WO 97/09042 contained one page of drawings with 3 figures on it, Figures 1 to 3. During the course of prosecution of the parent's applications, Applicants have submitted three Figures on individual sheets as "formal drawings". Applicants submitted the specification and the 3 additional sheets of Figures (as Formal Drawings). However to remove any confusion, Applicants request that the office consider the single sheet of figures contained in the "original" published PCT application as the basis of the specification. Applicants request that the USPTO consider the additional 3 sheets of

Figures, Figures 1 to 3 as a separate submittal for the purposes of Formal Drawings should the Draftsmen so request "corrected drawings".

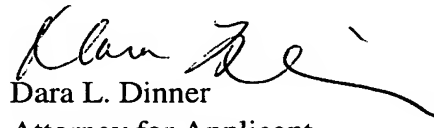
Applicants respectfully disagree with the Petition Office in the allegation that Applicant should have expected the USPTO to treat the copy of WO 97/09042 cited on the accompanying IDS/1449 form as a copy of the original application. In fact, one copy of WO 97/09042 accompanied the transmittal letter, and contributing to the confusion herein, a second "copy" accompanied the group of cited references on Applicants IDS/1449. The 1449 form was prepared for use in the parent applications and other related applications, and as such included WO 97/09042 on it. This was obviously redundant as this case is a divisional of that 371 national stage entry parent application. What Applicants believe happened is that the application/scanning division mistook the "original" WO 97/09042 publication (submitted as an original copy of the parent from which it was derived) as a piece of prior art and then discarded it upon scanning. Therefore, no specification existed as the "original" to form the basis of the specification for the file.

Applicants also refute that it is necessary for the declaration to refer to WO 97/09042 explicitly as the declaration does refer to PCT/US96/14554 under the appropriate section.

In conclusion, Applicants respectfully request reconsideration of the petition dismissal and award Applicants their filing date of 21 November 2003.

It is not clear is another \$130.00 petition fee or any additional fees or charges are required by this paper. If so, the Commissioner is hereby authorized to charge Deposit account 19-2570 accordingly. If any additional information is believed necessary for a resolution of this problem, the Commissioner is requested to contact the undersigned at the number indicated below.

Respectfully submitted,


Dara L. Dinner
Attorney for Applicant
Registration No. 33,680

GLAXOSMITHKLINE
Corporate Intellectual Property UW2220
P.O. Box 1539
King of Prussia, PA 19406-0939
Phone (610) 270-5017
Facsimile (610) 270-5090



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Corporate Intellectual Property - UW2220
P.O. Box 1539
King of Prussia, PA 19406-0939

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OFFICE OF PETITIONS

ON PETITION

In re Application of
Burch et al.
Application No. 10/719,211
Filed: November 21, 2003
Attorney Docket No. P50383D2

This is a decision on the petition filed August 11, 2004, to accord the above-identified application a filing date of November 21, 2003.

The petition is **dismissed**.

On November 21, 2003, the application was filed.

Petitioner filed:

- (1) 3 pages of drawings,
- (2) 3 pages of declaration,
- (3) 1 page of transmittal letter,
- (4) 6 pages of preliminary amendment,
- (5) 1 page of abstract, and
- (6) IDS and papers related to IDS.

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On May 27, 2004, the Office of Initial Patent Examination mailed a Notice stating that a specification was not present and that a filing date had not been accorded and the filing date would be the date of receipt of a specification.

The first sheet of the Information Disclosure Statement lists many documents including WO 97/09042. The papers filed on November 21, 2003, included a copy of many of the documents listed including WO 97/09042.

Apparently, petitioner is alleging the Office should have treated WO 97/09042 as the application - specification, drawings, and claims.

If WO 97/09042 is used as the application, then the postcard receipt contradicts the facts alleged by petitioner. The postcard indicates 3 sheets of drawings were filed, while the file contains 4 sheets of drawings including 3 filed as part of the original "application" and one sheet filed as part of WO 97/09042. The Office also notes that the declaration fails to explicitly refer to WO 97/09042.

Petitioner has failed to prove the May 27, 2004 Notice was mailed in error and the \$130 petition fee will be charged to petitioner's deposit account.

Since the copy of WO 97/09042 was filed on November 21, 2003, with the application papers, the papers may be used as the application *upon grant of a petition*. The petition will not be granted at this time because petitioner has failed to state which set of drawings the Office should

use as part of the official application. Should the Office use the 3 sheets of drawings with one Figure on each sheet or should the Office use the one sheet of drawing which is included as part of the application?

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petition
 Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

By facsimile: (703) 872-9306
 Attn: Office of Petitions

Any request for reconsideration must be filed within two months of the mailing date of this decision. Extensions of time under 37 CFR 1.136(a) are not available.

If a request for reconsideration is filed, and a decision on the new petition is not received within three months, petitioner may wish to call the number below to check on the status of the renewed petition.

The Office of Initial Patent Examination will be instructed that the petition was dismissed.

Telephone inquiries should be directed to Petitions Attorney Steven Brantley at (571) 272-3203.



Charles Steven Brantley
Senior Petitions Attorney
Office of Petitions